

were present upon the filing of the FWC on July 15, 2002 and cannot be withdrawn from consideration without a new election by Applicants.

The Examiner has relied upon MPEP § 821.03 to justify the withdrawal of Claims 5-7 from consideration. However, the Examiner's attention is respectfully drawn to MPEP § 819:

Where a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is a continuation of its parent application and not a divisional, or where a File Wrapper Continuation (FWC) filed under former 37 CFR 1.62, is a continuation of its parent application and not a divisional or C-I-P, an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application *unless otherwise indicated by applicant*. In no other type of continuing application may an election carry over from the prior application.

Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. *Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (A) a divisional or (B) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.* (Emphasis added.)

In the present application, the FWC application, as filed, included Claims 5-7 which were introduced in the amendment of December 17, 2001, which was prior to the first action in the CPA and, indeed, was prior to the filing of the FWC itself. This constitutes an indication in the FWC application that a change in election is desired, in accordance with example (B) of the MPEP. In such a case, the Examiner cannot simply withdraw claims from consideration, but is required to issue a new restriction requirement.

Applicants consider paragraph 2 of the Office Action to be such a Restriction Requirement, and hereby elect the method Claims 5-7. Claims 1-4 have therefore been cancelled.

Applicants request a first Office Action on the merits of Claims 5-7. Applicants submit that Claims 5-7 define over the prior art.

Claim 5 recites a process of manufacturing an thermoinsulating flexible mat of mineral fibers having quasi-random orientation, in which doubly crimped fibers of the thermoinsulating flexible matter are formed by a first step of longitudinal compression to produce a felt of an undulating fiber structure, and a second step of longitudinal compression of the felt having the undulating fiber structure to produce a compressed mat having a random arrangement of the fibers. This is shown by the undulations illustrated at zone IIa in the figure, and the random arrangement shown at zone IIIa in the figure. Claims 6 and 7 recite the speed ratios described in the first two paragraphs of page 5.

Claim 5 is a method claim which differs from the product claims which Board of Appeals had confirmed were unpatentable over Debouzie et al in the parent application. Specifically, the product claims considered by the board had not recited that the double crimped fibers are formed by a first step of producing a felt of an undulating fiber structure and a second step of producing a random arrangement of the fibers, and so the Board had not addressed the patentability of a method claim reciting this feature. In fact, the first step of the process according to the present invention produces a crimping effect and undulation of the felt to create a very low density product of very fine fibers. The second step destroys the crimped structure of the intermediate product and produces a randomly oriented fiber structure with low density.

Applicants respectfully submit that Claim 5 clearly defines over Debouzie. The process described by Debouzie et al is intended to produce products with high compression ratios, but without the formation of creases (col. 2, line 39), wherein the products exhibit a fiber orientation, which if not isotropic then at least is more than random.

This is done by a process including multiple stages of compression and limiting the compression imposed at each of the stages (col. 4, line 14) in such a way that no crease is formed at any stage of the longitudinal compression.

From the description of the detailed embodiment on column 10 of Debouzie et al, one can make following calculation of the longitudinal compression ratio.

<u>Speeds</u>	<u>Speed ratio with preceding step preceding step</u>	
<u>Felt formation</u>		
(see col. 10, 1. 14)	<u>30 m/min</u>	
<u>Vertical compression</u> at conveyors 7-8		
see col. 10, 1.16 in connection with 1.38)	<u>35 m/min</u>	substantially the same
<u>First longitudinal compression</u> at conveyors 9-10		
(see col. 10, 1.40) 18-20 m/min	1.75 - 1.94	
<u>Second longitudinal compression</u> at conveyors 11-12		
(see col. 10, 1.4 which contains a clerical error, the correction of which is evident from col. 10, 1.21 because the speed in the oven acid downstream cannot be higher than the upstream speed, thus figure "1" as a lower limit was certainly intended to be "7")	<u>7-10 m/min</u>	1.80 - 2.86

As is evident from this comparison, the first step of the inventive process produces an actual crimping effect, which produces an undulated structure in which the initial felt is a very low density product with very fine fibers.

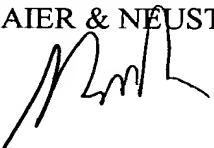
Such effect is absolutely not taught by Debouzie et al., who clearly state that any crimping (meaning crease formation) is to be avoided, and is actually avoided with the process. Claim 5 therefore clearly defines over this reference.

Since Claims 6 and 7 require that the conveyors have a speed ratio of 2.5 to 1, and this is not true for the two steps of Debouzie (see Table above), the dependent claims are believed to define over this reference for this reason as well.

Applicants therefore believe that the present application is in a condition for allowance and respectfully solicit an early notice of allowability.

Respectfully submitted,

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IN THE CLAIMS

Please cancel Claims 1-4.